

ADMINISTRATIVE PANEL DECISION

Merck KGaA v. Sanders Colonel

Case No. D2022-4335

1. The Parties

The Complainant is Merck KGaA, Germany, represented by Živko Mijatović & Partners d.o.o. Beograd.

The Respondent is Sanders Colonel, Cameroon.

2. The Domain Name and Registrar

The disputed domain name <merck-export.com> is registered with PlanetHoster Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2022. On November 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 17, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 21, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center sent an email communication in both French and English regarding the language of the proceeding. The Complainant filed an amended Complaint on November 23, 2022 as well as a Language of Proceeding request demanding the proceeding to be in English. The Respondent did not submit any comments regarding the Language of Proceedings.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint in English and in French, and the proceedings commenced on December 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 22, 2022.

The Center received an informal communication seemingly from the Respondent on December 23, 2022 to which the Center acknowledged receipt.

The Center appointed La Spada, Anne-Virginie as the sole panelist in this matter on December 29, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a pharmaceutical and chemical company founded in Germany in 1850.

Among other registrations, the Complainant owns the International trademark registration No 1349459 for MERCK, registered on November 2, 2016, in Classes 1, 2, 3, 5, 7, 9, 10, 11, 16, 17, 29, 30, 32, 35, 40, 41, 42 and 44.

The Complainant states that it is also the owner of more than 2,500 domain names containing the term “merck”.

The disputed domain name was registered on May 27, 2022.

At the time of the filing of the Complaint, the disputed domain name redirected Internet users to a website purportedly offering for sale various infant formulas.

5. Parties' Contentions

A. Complainant

According to the Complainant, the disputed domain name is confusingly similar to its registered trademark MERCK as it reproduces its trademark with the mere adjunction of a hyphen and the generic term “export”.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not authorized by the Complainant to use its trademark in connection with the disputed domain name, and there is no indication that the Respondent is known under the disputed domain name. The Respondent has not used the disputed domain name in connection with any *bona fide* offering of goods or services, nor is the Respondent making any legitimate non-commercial use of the disputed domain name.

The Complainant finally contends that given the well-established reputation of its trademark MERCK, the Respondent was aware of it at the time of registration of the disputed domain name. According to the Complainant, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark. The overlap of the classes for which the Complainant's trademark is protected (class 5 - food for babies and children) and the products sold on website connected to the disputed domain shows a clear attempt on the part of the Respondent to pass off the website as being associated with or endorsed by the Complainant. Moreover, the Respondent is using the business name of the Complainant's affiliate Merck Export GmbH, and even its address, with minor typographical errors. The fact that the Respondent used a privacy service to hide its identity and the fact that he never responded to a cease-and-desist letter is according to the Complainant further evidence of bad faith.

B. Respondent

The Respondent did not submit a formal reply to the Complainant's contentions. The Panel notes that the informal email communication, received on December 23, 2022, does not alter the Panel's assessment of the case.

6. Discussion and Findings

6.1 Language of the proceedings

The Complainant submitted its Complaint in English. The Registrar informed the Center that the language of the registration agreement of the disputed domain name was French. The Complainant subsequently requested that English be the language of the proceedings.

According to paragraph 11 (a) of the Rules, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

UDRP panels may accordingly allow that proceedings be conducted in another language than the registration agreement, if the circumstances warrant it (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1). This provision must be applied in accordance with paragraphs 10(b) and 10(c) of the Rules, requiring that the parties be treated equally, that each party be given a fair opportunity to present its case and that the proceeding take place with due expedition. Moreover, the language of the proceeding must also ensure the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes (see *Banque Pictet & Cie SA v. Hu Deng Xia*, WIPO Case No. [D2015-0781](#)).

In support of its request that English be the language of the proceedings, the Complainant submits that the Respondent appears to be domiciled in Cameroon, a country where English is an official language. The Complainant furthermore submits that the website to which the disputed domain name redirects is entirely in English and that prices are indicated in USD.

Finally, the Respondent sent an informal communication to the Center in English after being notified of the Respondent's Default.

In view of the above, the Panel finds it likely that the Respondent has a sufficient command of English, and that it would put an undue burden on the Complainant if it had to translate the Complaint into French.

Therefore, the Panel accepts the Complainant's request and holds that English is the language of the proceedings.

6.2 Substantive elements of the Policy

According to paragraph 4(a) of the Policy, a complainant must assert and prove each of the following:

- (i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name registered by the respondent has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name reproduces the Complainant's trademark MERCK in its entirety with no alteration and combines this trademark with a hyphen and the term "export".

UDRP panels consider that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy (see section 1.8 of the [WIPO Overview 3.0](#)).

In the present case, the trademark MERCK is clearly recognizable in the disputed domain name. The mere addition of the term "export" and the punctuation mark "-" do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

UDRP panels accept that a generic Top-Level Domain ("gTLD"), such as ".com", may be disregarded when assessing whether a domain name is identical or confusing similar to a trademark (see [WIPO Overview 3.0](#), section 1.11).

The Complainant has satisfied the condition set forth in paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the information submitted by the Complainant, the Respondent does not appear to have rights or legitimate interests in respect of the disputed domain name, nor has the Complainant granted to the Respondent an authorization to use its trademark in the disputed domain name. Moreover, there is no evidence indicating that the Respondent is commonly known by the disputed domain name.

In addition, based on the evidence provided by the Complainant, the Respondent uses the confusingly similar disputed domain name to redirect Internet users to a website offering for sale infant formulas, products that are included in the Complainant's field of activity. This does not appear to be a legitimate non-commercial purpose.

Furthermore, the composition of the disputed domain name carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

Finally, the Respondent did not file a response to the Complaint. The Panel may draw from the lack of a Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b).

In view of the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the Respondent's silence corroborates such *prima facie* case.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Complainant has satisfied the condition set out in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Considering the distinctiveness and reputation of the Complainant's MERCK trademark, the Panel accepts that the Respondent most probably knew of the Complainant's trademark when it registered the disputed domain name.

The Respondent used the disputed domain name to redirect Internet users to a website offering for sale various infant formulas. The Respondent used on such website the business name of the Complainant's affiliate Merck Export GmbH and its street address, with minor typographical errors.

UDRP panels have found that redirecting a domain name to a third party website may support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark, a behavior which amounts to bad faith according to paragraph 4(b)(iv) of the Policy (see [WIPO Overview 3.0](#), section 3.1.4).

In the present case, the Respondent did not only use the disputed domain name in connection with a website offering competing products but also sought to impersonate the Complainant's affiliate. Such use of the disputed domain name was clearly likely to mislead Internet users into believing that the website at issue was an official website of the Complainant, for the commercial gain of the Respondent. This amounts to use in bad faith according to paragraph 4(b)(iv) of the Policy.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has satisfied the condition set forth in paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <merck-export.com> be transferred to the Complainant.

/Anne-Virginie, La Spada/

Anne-Virginie, La Spada

Sole Panelist

Date: January 12, 2023